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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,584	03/18/1999	EDUARDO BLUMWALD	4001	4345

7590 08/06/2003

Morrison & Foerster LLP  
425 Market Street  
San Francisco, CA 94105-2482

EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

44

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/271,584

Applicant(s)

BLUMWALD ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 56.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,5,7,8,10-12,14,18,19, 21-32 and 53-54.

Claim(s) withdrawn from consideration: 15,16,33,48 and 49.

8. ☒ The proposed drawing correction filed on 18 March 2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

## Continuation of 2. NOTE:

New matter: The amendments to the specification are not supported by US Patent 5,756,684, incorporated by reference into the instant specification. '684 does not have a definition for "low stringency conditions", "moderately stringency conditions", or "high stringency conditions". Furthermore, column 35, lines 29-37 of '684 are drawn to Northern hybridization, not Southern hybridization and do not recite all the conditions recited in the instant amendment. Therefore the amendments to part (c) of claims 1, 18, and 53 are also new matter.

New considerations: 112, 2<sup>nd</sup>.

Claims 1 and 18, part (b), and claim 53, part (ii), insert --of-- after "sequence" OR "the amino acid sequence" should be deleted.

Claim 5, "1" has been deleted from the claim after "claim" without correctly marking the claim up. --1-- should be inserted after "claim"

Claim 31, line 3, replace "and" with --, wherein--

Claim 32, line 4, insert --relative to a plant that has not been transformed with the expression transgene-- before the period

Continuation of 3. Applicant's reply WOULD HAVE overcome the following rejection(s):

112, 1<sup>st</sup>, enablement and written description, 112, 2<sup>nd</sup>, 102 and 103.

## Continuation of 10. Other:

Sequence identifiers are missing from pg 39, line 6, pg 55, lines 26, 28 and 31, and pg 56, lines 13, 14, 28, 29, of the specification.

Claims to plants transformed with SEQ ID NO:1, nucleic acids encoding SEQ ID NO:2, or nucleic acids encoding Na<sup>+</sup>/H<sup>+</sup> transporters with 95% identity to SEQ ID NO:2 would be allowable, as would methods of using those nucleic acids to produce those plants.



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